

REMARKS

Claims 1-5, 8-12, 15, and 17 remain pending in this application. Claim 8 is amended, not for any reasons related to patentability, but to correct a minor error. Claims 6, 7, 13, and 14 were previously cancelled without prejudice to their underlying subject matter. New claims 19-39 are added.

Applicants acknowledge the Examiner's restriction-out of claims 16 and 18 and provisionally withdraw these claims from consideration. However, Applicants reserve the right to pursue any cancelled or withdrawn claims in this or other applications.

Claims 1-5, 8-12, 15, and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. patent 5,095,660 (Dillon) in view of U.S. patent 4,920,700 (Murahashi et al.). Applicants respectfully traverse this rejection.

Claim 1 defines an intermediate lens pad and recites, in part, "said pad having a first side and a second side, said first side capable of being secured to a curved surface of a lens tool when the pad is in use, and said second side having a substantially smooth surface comprising a multiplicity of holes or recesses substantially uniformly distributed over an entirety of said second side surface, said holes or recesses being at least an order of magnitude smaller than the intermediate lens pad," and "whereby a lens surfacing pad having a peel-off adhesive on one side and a working surface on its other side, can be secured by said adhesive side to said intermediate lens pad so as to inhibit relative movement between said intermediate lens pad and said lens surfacing pad during surfacing, while allowing ready manual removal of the surfacing pad for replacement by a different surfacing pad." Such a device is not taught or suggested by Dillon and Murahashi et al., whether taken individually or in combination.

As indicated in the Office Action, Dillon does not teach or suggest “a lens surfacing pad having a peel-off adhesive on one side” as recited by claim 1. Also, as further indicated in the Office Action, Dillon does not teach or suggest an intermediate lens pad having “a substantially smooth surface comprising a multiplicity of holes or recesses” as recited by claim 1. In view of this lack of disclosure in Dillon, the reference clearly does not teach or suggest that “a lens surfacing pad having a peel-off adhesive on one side and a working surface on its other side, can be secured by said adhesive side to said intermediate lens pad so as to inhibit relative movement between said intermediate lens pad and said lens surfacing pad during surfacing, while allowing ready manual removal of the surfacing pad for replacement by a different surfacing pad,” since such is related to the holes or recesses and smooth surface of the intermediate lens pad and the adhesive of the lens surfacing pad.

In addition, Dillon specifically discloses that its urethane pad frictionally supports a polishing cloth and that absolutely no adhesive is used or needed to secure the polishing cloth to the urethane pad. Column 1, lines 63-67; column 3, lines 14-16. Exclusive use of friction-support presents stability problems, which is a deficiency in the prior art addressed by the claimed invention. (see specification at paragraph 0003). This requirement of Dillon directly teaches away from the recited “peel-off adhesive” of the recited lens surfacing pad as defined by claim 1. In accordance with M.P.E.P. § 2144.05.III, a prima facie case of obviousness is rebutted by showing that a reference, in any material respect, teaches away from the claimed invention. Id. Further, this requirement of Dillon (i.e., no adhesive) also teaches away from the combination of Dillon and Murahashi et al. for the purpose stated in the Office Action, namely to add a teaching of use of adhesive on one side of a lens surfacing pad to Dillon’s disclosure.

Thus, these references cannot be combined in rejecting claim 1 under 35 U.S.C.

§ 103(a). M.P.E.P. § 2145.X.D.2.

Even assuming arguendo that Dillon and Murahashi et al. could properly have been combined, which they could not, their combined disclosures still would not have taught or suggested the subject matter of claim 1. Murahashi et al. does not teach or suggest an intermediate lens pad or use of an intermediate lens pad. Instead, the reference discloses adhesively-securing a processing pad directly to a finishing dish (i.e., part of a lens shaping tool). Use of adhesive makes removal of the processing pad difficult, which is a deficiency in the prior art addressed by the claimed invention. (see specification at paragraph 0003). Murahashi et al. does not teach or suggest “recesses and protuberances” as indicated by the Office Action. No such texture of a pad is disclosed in the reference; nowhere does Murahashi et al., including the cited portions, disclose that its sintered aluminum oxide layer incorporates any specific texture, such as the recited “holes or recesses” of claim 1. Sintered aluminum oxide is an abrasive surface, which would not provide a “substantially smooth surface comprising a multiplicity of holes or recesses” as recited for the intermediate lens pad of the claim.

Because neither Dillon nor Murahashi et al., individually or in combination, would have rendered the claimed subject matter obvious, because Dillon teaches away from the claimed invention, and since the combination of references is improper, independent claim 1 and dependent claims 2-5 are patentable over the cited references. Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claims 1-5 be withdrawn.

Claim 8 defines an intermediate lens pad and recites, in part, “said second side having a substantially smooth surface defined by outer surfaces of a multiplicity of

protuberances substantially uniformly distributed over said second side surface such that the distance between adjacent protuberances is an order of magnitude smaller than the intermediate lens pad,” and “whereby a lens surfacing pad having a peel-off adhesive on one side and a working surface on its other side, can be secured by said adhesive side to said intermediate lens pad so as to inhibit relative movement between said intermediate lens pad and said lens surfacing pad during surfacing,” and “while allowing ready manual removal of the surfacing pad for replacement by a different surfacing pad.” As with claim 1, this system is not taught or suggested by Dillon and Murahashi et al., whether the references are combined or not.

Claim 8 is patentable over Dillon and Murahashi et al. for the same or similar reasoning to that set forth above in relation to the patentability of claim 1. For example, neither references teaches or suggests the recited limitations of claim 8 relating to adhesion of the surfacing pad to the intermediate pad, a plurality of protuberances on a substantially smooth surface of an intermediate lens pad, or a configuration of protuberances and adhesive for removal of a surfacing pad from an intermediate pad. For at least these reasons, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of independent claim 8 and dependent claims 9-12 be withdrawn.

Claim 15 defines a lens tool assembly and recites, in part, “an intermediate lens pad secured with adhesive to said curved surface of the lens tool” and “a lens surfacing pad having one side provided with an adhesive layer by which said lens surfacing pad is secured to said intermediate lens pad,” and “wherein an outer surface of the intermediate lens pad is substantially smooth and comprises a multiplicity of holes or recesses substantially uniformly distributed over an entirety of the outer surface, said holes or recesses being at least an order of magnitude smaller than the intermediate lens pad.” For at least the same reasoning set forth above relating to the

patentability of claim 1, claim 15 is patentable over Dillon and Murahashi et al., whether taken individually or in combination.

For example, neither reference teaches or suggests the recited limitations relating to a lens surfacing pad secured by an adhesive to an intermediate lens pad or a textured outer surface of an intermediate lens pad. For at least these reasons, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of claim 15 be withdrawn.

Claim 17 defines a lens tool assembly and recites, in part, "a lens surfacing pad having one side provided with an adhesive layer by which said lens surfacing pad is secured to said intermediate lens pad," and "wherein an outer surface of the intermediate lens pad is substantially smooth and is defined by outer surfaces of a multiplicity of protuberances substantially uniformly distributed over the outer surface such that the distance between adjacent protuberances is an order of magnitude smaller than the intermediate lens pad." For at least the same reasoning set forth above in relation to the patentability of independent claim 1, claim 17 is likewise patentable over Dillon and Murahashi et al., whether taken individually or in combination.

For example, neither Dillon nor Murahashi et al. teaches or suggests the recited limitations of claim 17 relating a lens surfacing pad secured to an intermediate lens pad with adhesive or an outer surface of an intermediate lens pad having a substantially smooth surface and protuberances. For at least these reasons, independent claim 17 is patentable over Dillon and Murahashi et al. and the 35 U.S.C. § 103(a) rejection of this claim is respectfully requested to be withdrawn.

Newly presented claims 19-39 are patentable over the cited prior art for the same or similar reasoning as set forth above relating to the patentability of claims 1-5, 8-

12, 15, and 17. Also, the newly presented claims are patentable over the prior art for other reasons as well relating to limitations of the new claims, which are not discussed above, but provide a different scope of protection relating to the invention. The consideration and allowance of these new claims is respectfully requested.

In view of the above, each of the presently pending claims (1-6, 8-12, 15, 17, and 19-39) in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Dated: October 1, 2003

Respectfully submitted,

By  _____

Donald A. Gregory

Registration No.: 28,954

Ryan H. Flax

Registration No.: 48,141

DICKSTEIN SHAPIRO MORIN &

OSHINSKY LLP

2101 L Street NW

Washington, DC 20037-1526

(202) 785-9700

Attorney for Applicants